

REMARKS

Claim 23 has been canceled without prejudice; the subject matter of claim 23 has been included in claim 1. Claim 1 has been amended for greater clarity. The amendments are made solely to expedite prosecution of the application, and Applicants reserve the right to prosecute claims of similar or differing scope in subsequent applications. Support for the claim amendments can be found throughout the specification and original claims. Further, these claim amendments are fully supported by the working examples (e.g., pages 14-24). No new matter has been introduced. Claims 3, 5, 7, 8, 9, 12, 13, 14, and 19 have been amended solely to change claim dependency.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

Election/Restriction

Applicants note that the Examiner has withdrawn claims 5-6 and 14-22 as being drawn to a nonelected invention.

Claim Objections

The Examiner objects to claims 1, 3-4, 7-13, and 23 for containing improper amendment formats. In response, Applicants have amended claims 1, 8, and 13 to correct the improper use of brackets and improper strike-through of a single letter, thereby obviating the objections.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

Claims 1, 3-4, 7-13, and 23 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse these rejections to the extent it is maintained over the claims as amended.

Specifically, the Office Action asserts that the previous introduction of “provided that a fragment that includes residues 624-1287 of TIF-2 is excluded” into claim 1 resulted in the introduction of new matter because this limitation to the claimed method is not described or present in the specification as filed and this particular TIF-2 fragment in the context of the claimed invention is not set forth in the specification as filed as being in the prior art (see Office Action, page 5, lines 1-7).

Applicants reiterate the arguments already made of record and contend that one of skill in the art can readily envision the claimed subject matter in view of the teachings of the specification. Nevertheless, solely to expedite prosecution of the application, Applicants have amended independent claim 1 to remove the recitation of “provided that a fragment that includes residues 624-1287 of TIF-2 is excluded” and to specify that “the fragment comprises only one signature motif.” Support for the claim amendments can be found throughout the specification. For example, the specification teaches that “we constructed a series of proteins consisting of a DBD fused to eight to ten amino acids incorporating one copy of each of the nine LXXLL motifs. As shown in Fig. 1a, each of the nine motifs present in RIP140 displayed strong ligand-dependent interaction with the LBD of the ER whereas the DBD alone showed no ability to bind” (e.g., page 14, lines 14-18). In light of the detailed description provided by the specification, one of skill in the art would readily appreciate that Applicants were in possession of the claimed invention at the time this application was filed.

Accordingly, Applicants submit that independent claim 1 as amended and all claims depending therefrom comply with the written description requirement. Reconsideration and withdrawal of the written description rejections are respectfully requested.

Claim Rejections under 35 U.S.C. § 102(e)

Applicants note with appreciation that the Examiner has withdrawn the rejections under 35 U.S.C. § 102(e) in view of Applicants’ Amendment and arguments filed on December 18, 2002.

Further, Applicants submit that the claims as amended are not anticipated by the previously cited prior art, Chambon *et al.* Independent claim 1 as amended recites a method for identifying an inhibitor compound capable of reducing the interaction between a first region and a second region, comprising:

- a) placing in contact:
 - i) a potential inhibitor compound;
 - ii) a first region which is a fragment of a nuclear protein, wherein the fragment comprises only one signature motif B¹XXLL, in which B¹ is any natural hydrophobic amino acid, L is leucine, and X independently represents any natural amino acid, and the signature motif is a structural element of a nuclear protein that binds to a liganded nuclear receptor in the process of activating or repressing target genes, and the nuclear protein is a bridging factor responsible for an interaction between a liganded nuclear

receptor transcription factor and a transcription initiation complex involved in regulation of gene expression;

iii) a second region which is a liganded nuclear receptor transcription factor or a fragment thereof, wherein the fragment comprises that part of the nuclear receptor which is capable of interacting with the nuclear protein through binding to the signature motif; and

b) detecting the presence or absence of inhibition of the interaction between ii) and iii).
(emphasis added)

The standard for anticipating a claim is clearly outlined in MPEP 2131, and this standard is further supported by the Courts. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1978).

Applicants contend that Chambon *et al.* fail to satisfy this criteria for anticipating the present invention. Chambon *et al.* describe a TIF 2 fragment containing four signature motifs, rather than only one signature motif as recited in the present invention. Thus, Chambon *et al.* fail to meet the limitations of independent claim 1 and thus fail to anticipate the claimed subject matter. For the same reasons, all claims depending from claim 1 are not anticipated by Chambon *et al.*

Accordingly, the claimed invention (as amended) is novel over Chambon *et al.*
Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the above remarks, Applicants believe that the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. Applicants hereby petition for a three-month extension of time and appropriate fees to file this response to the Office Action. Applicants believe that no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. ASZD-P01-228 from which the undersigned is authorized to draw.

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Respectfully submitted,

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